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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,882

03/06/2002

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EXAMINER

MAGUIRE, LINDSAY M

ART UNIT

PAPER NUMBER

3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/091,882	Applicant(s) SINGHAL, TARA CHAND	
	Examiner LINDSAY M. MAGUIRE	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Non-Final Office action is in response to the application filed on March 6, 2002, the amendments filed on July 9, 2007, and the Request for Continued Examination filed on December 6, 2007.

Drawings

The drawings were received on December 6, 2007. These drawings are accepted.

Specification

The amendments to the specification are objected to as the amendments are not clearly shown in the papers filed on December 6, 2007. Specifically, nothing is underlined or crossed-through so as to indicate amended areas.

Election/Restrictions

Newly submitted claims 18-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the added recitations of, "an encoded service code, the code embeds merchant identification to a third party central system" (claim 18, line 4; similarly recited in claims 24 and 30) and, "where the payment transaction request to the central system, having originated from the wireless device of the customer did not originate from the merchant computer system" (claim 18, lines 15-17; similarly recited in claims 24 and 30) are not present in

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the originally filed claims 1-17. It was not a requirement of the previously filed claims that the central system be operated by a third party, nor was it a requirement that the payment request not originate from the merchant computer system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

In the interest of compact prosecution the claims have been examined, and art has been applied.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18, 22, 24, 28, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the recitations, “an encoded service code, the code embeds merchant identification to a

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third party central system” (claim 18, line 4; similarly recited in claims 24 and 30) and, “where the payment transaction request to the central system, having originated from the wireless device of the customer did not originate from the merchant computer system” (claim 18, lines 15-17; similarly recited in claims 24 and 30) are not present in the specification. There is no mention in the specification of a third party system, or any other function being performed by a ‘third’ party. Furthermore, regarding the recitation, “where the payment transaction request to the central system, having originated from the wireless device of the customer did not originate from the merchant computer system” (claim 18, lines 15-17; similarly recited in claims 24 and 30), any negative limitation or exclusionary proviso must have basis in the original disclosure. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977).

Additionally, the recitations, “the service code embeds in addition to the merchant identification...system [.]” (claim 22, lines 3-5; similarly recited in claim 28) and, “updates payment status data using a plurality of fields from a group of fields...status[.]” (claim 23, lines 2-5; similarly recited in claim 29) are also not present in the specification. It is noted that cancelled claim 10 recited, “a customer receiving a paper bill from the restaurant merchant, printed with a service code.” However, there is a considerable difference between the service code being printed on a receipt, as in the cancelled claims, and the code being embedded as is required by the new claims, and is therefore not supported in the original disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-32 are rejected, inasmuch as the claims are best understood given the 35 U.S.C. 112 rejections (as advanced above), under 35 U.S.C. 103(a) as being unpatentable over Showghi et al. '739, alone.

Showghi et al. '739 disclose privacy payment system/method that provides privacy of customer bankcard data, comprising: a. a bill that shows a payment amount and a service code (column 5, lines 17-22); b. a wireless device of a customer (22, 24, 26; Figure 2) with, (i) means for entering the code, a payment amount (column 5, lines 17-22 & column 7, lines 43-55), and (ii) means for sending the data to the central system which pre-stores customer data and merchant data (i.e. wireless; Figure 2); c. central system (16, 18) means for identifying the customer and processing a payment request from the customer to the merchant by retrieving customer and merchant data and submitting a payment transaction request to an existing payment authorization network (column 7, lines 43-55); d. central system (16, 18) means for receiving a payment approval record and sending payment approval notification to the customer on the wireless device (column 7, lines 43-55; i.e. acknowledges receipt of goods, acknowledges that the payment is going through); e. central system means for sending

payment approval notification to a merchant computer system (column 7, lines 43-55).

Showghi et al. '739 additionally disclose, that the central system stores (i) customer identification means, (ii) a plurality of customer bank account data and (iii) wireless device notification means (column 7, lines 43-47); the customer identification means using a personal number that is a combination of wireless device telephone number and a personal identification number that is entered into the wireless device (if a person is using their own wireless device, i.e. 22, 24, 25, then their phone number is obviously contained within their personal number); the central system stores merchant identification that identify the merchant to a payment authorization network and merchant computer system notification means (column 5, lines 29-32; column 7, lines 43-55); where the restaurant bill, further comprising: the service code includes in addition to the merchant identification (i.e. venue code), a table number (i.e. seat number) and a server number (i.e. delivery person), which may be used to track payments from customers by the central system and conveyed to the merchant computer system; a display terminal interfaced to the merchant computer system displays table number (seat number), server number (delivery person), and payment status (column 4, lines 20-24; column 7, lines 43-55).

Showghi et al. '739 disclose the invention substantially as claimed with the exception of requiring: (a) a restaurant bill (claim 18, line 3; claim 24, line 3; claim 30, line 3); and (b) means for imputing an optional tip (claim 18, lines 3-4).

With respect to (a), Showghi et al. '739 disclose that the items purchased can be those of food for delivery from a vendor in a confined area which constitutes a restaurant. Therefore, it would have been obvious to one of ordinary skill in the art at that the system could be used in a restaurant, since it is already being employed in a venue acting as a restaurant.

Regarding (b), Showghi et al. '739 disclose that the approval data would include the table number (seat number) and the server number (i.e. the deliverer). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an option to tip the delivery person who is delivering the ordered items to the patrons seat, since it is well known in the art to tip a person who is providing a service, and to provide an easy way for the patron to tip the deliverer without needing to carry cash. Additionally it is well known in the art to allow a patron to raise the amount of the total of their bill for the purposes of tipping or receiving cash back.

Response to Arguments

Applicant's arguments with respect to claims 18-32 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments that, "Showghi teaches a food ordering mechanism from a seat in a sport stadium from a food vendor using a wireless device that is loaned to the customer for the venue event at the stadium by the food vendor [.]” are acknowledged,

however examiner is of another opinion. Specifically, Showghi et al. '739 discloses that the devices used can be those of a two-way pager (22), cell phones (24), and PDAs (26). Showghi et al. '739 further states, "Customers having their own compatible communication device 22, 24, 26 need only enter this serial number into the device and provide payment information when ordering items[.]" (column 5, lines 19-22) and, "At the end of the event patrons having a conventional communication device 22, 24, 26, merely pocket their devices and exit the venue [.]" (column 7, lines 56-58). Both of these recitations support that the invention of Showghi et al. '739 supports devices that are owned by the user in addition to those that can be rented from the facility.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to re t whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1/15/08
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